



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/966,424	09/28/2001	Kari M. Maki	FORSAL-25	6386

20455 7590 10/22/2003  
LATHROP & CLARK LLP  
740 REGENT STREET SUITE 400  
P.O. BOX 1507  
MADISON, WI 537011507

EXAMINER

NGUYEN, TAN D

ART UNIT PAPER NUMBER

3629

DATE MAILED: 10/22/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/966,424

Applicant(s)

MAKI, KARI M.

Examiner

Tan Dean Nguyen

Art Unit

3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 14 January 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) Z.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Information Disclosure Statement***

The prior art statement filed 1/14/02 has been received and recorded.

### ***Claim Rejections - 35 USC § 112***

1. Regarding claim 1, the phrase "such as" on line 1 and "the like" on line 2 renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).
2. Claims 12-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 12 is partially written in inactive/passive state "information is transferred to a service system server and further includes a service unit" and "said service unit is established a secured communications connection comprising" are vague and indefinite. Converting the phrases to active/positive statements are recommended to improve clarity and overcome the rejections.

On claim 18, the phrase "the system of any claim 12" is vague.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 3629

4. Claims 1-11, 19, 12-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 0 822 473 in view of EP 0 825 506 and MOTOYAMA (US Patent 5,909,493).

As for claims 1, 19, in a remote method and apparatus for maintenance process, EP 0 822 473 fairly discloses a method for servicing a production plant (industrial and manufacturing apparatus such as semiconductor device) comprising the steps of: gathering information related to the manufacturing processes and machinery of a production plant by means of at least one information system and/or measurement unit and/or production control unit (106), sending the collected information from the production plant to a remote service unit (108), isolating the information network of the service unit from the Internet by a firewall and transferring the information bidirectionally between the production plant and the information network of the service unit in a secured format (Fig. 1, Fig. 2, col. 3, lines 4-58, col. 4, lines 3-48, col. 7, lines 22-26). As for the limitation of the type of the production plant, such as a paper mill, board mill, etc., EP 0 822 473 generally teaches an industrial manufacturing plant, therefore, the selection of other similar manufacturing plant such as for manufacturing paper or pulp, would have been obvious as mere applying to other manufacturing plant. Therefore, EP 0 822 473 discloses the claimed invention except for having a service system server for collecting information from different information systems of the plant, and isolating the internal information network of the production plant from the Internet by a firewall.

In a similar method and apparatus for remote process control, EP 0 825 506 discloses the use of a central information service system server (20) for collecting

information from local information systems (measurement units, sensing devices, etc) (19a-19e) and responsible for establishing communications over the Internet network with remote service unit (col. 3, lines 40-50, col. 4, lines 15-55). It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the process of EP 0 822 473 to include a central information service system server for collecting local information network of the production plant as taught by EP 0 825 506 for establishing communications over the network.

MOTOYAMA is cited to teach well known step or means for additional security measure used in connecting a computer network to the Internet a protective device known as firewall to allow only authorized computers/users to access a network or other computer via the Internet (see fire wall 14, fire wall 50, fire wall 40) (see Fig. 1, col. 4, lines 15-25). It would have been obvious to modify the process of EP 0 822 473/EP 0 825 506 by providing a firewall to isolate the internal information network of the production plant from the Internet to provide additional security measure as taught by MOTOYAMA above.

As for claim 2, MOTOYAMA discloses the network (16) within the confines of firewall 14 prior to connecting to the Internet (10), therefore the disclosure of a similar setup of a firewall connected between the Internet and the system service server would have been obvious to avoid unauthorized access to the server from the Internet network. As for claim 3, the treating and processing of data are fairly taught in EP 0 825 506 col. 4, lines 15-40, Fig. 2, digital data processors 12, 14. As for claim 4, the use of ID codes or passwords to authorize users is well known and would have been obvious

Art Unit: 3629

to implement. As for claim 5, this is inherently in the process of EP 0 822 473 wherein the host computer (108) is remote from the manufacturing plant (see abstract, col. 6, lines 15-30, Fig. 4). As for claim 6, the collection of the information from a plurality of units is taught on Fig. 1 of EP 0 822 473 (102, 103, 104). As for claim 7, this is inherently included in the system of EP 0 822 473/EP 0 825 506 and MOTOYAMA when the information is sent between the systems. As for claim 8, the analysis step is taught in EP 0 822 473 Fig. 2, 3, 5. As for claims 9-10, the recommendation step is taught on Figs. 3-5 of EP 0 822 473. As for claim 11, the transfer of data signals are inherently included and taught in EP 0 822 473 col. 3 lines 5-55 or digital data processors 12, 14 of Fig. 1 or col. 4, lines 5-40 of EP 0 825 506.

As for apparatus claim 12, it is rejected for the equivalent system for arranging the maintenance of a production plant as shown in claim 1 or 19 above. As for claims 13-18, they are rejected for the same reasons set forth in claims 2-7 above.

Art Unit: 3629

5. Telephone inquiries regarding the status of applications or other general questions, by persons entitled to the information, should be directed to the group clerical personnel and not to the examiner. As the official records and applications are located in the clerical section of the examining Tech Center, the clerical personnel can readily provide status information without contacting the examiner. See MPEP 203.08. The Tech Center clerical receptionist number is (703) 308-1113.

In receiving an Office Action, it becomes apparent that certain documents are missing, e. g. copies of references, Forms PTO 1449, PTO-892, etc., requests for copies should be directed to Tech Center 3600 Customer Service at (703) 306-5771, or e-mail CustomerService3600@uspto.gov .

Any inquiry concerning the merits of the examination of the application should be directed to Dean Tan Nguyen at telephone number (703) 308-2053. My work schedule is normally Monday through Friday from 7:00 am through 4:30 pm.

Should I be unavailable during my normal working hours, my supervisor John Weiss may be reached at (703) 308-2702. The FAX phone numbers for formal communications concerning this application are (703) 872-9306. Informal communications may be made, following a telephone call to the examiner, by an informal FAX number to be given.

Other possibly helpful telephone numbers are:

Allowed Files & Publication	(703) 305-8322
Assignment Branch	(703) 308-9287
Certificates of Correction	(703) 305-8309
Drawing Corrections/Draftsman	(703) 305-8404/ 8335
Fee Questions	(703) 305-5125
Intellectual Property Questions	(703) 305-8217
Petitions/Special Programs	(703) 305-9282
Terminal Disclaimers	(703) 305-8408
Information Help Line	1-800-786-9199

dtn  
October 20, 2003

  
DEAN T. NGUYEN  
PRIMARY EXAMINER